REMARKS

This Amendment is in response to the Office Action dated July 19, 2005. In the Office Action, the Examiner rejected claims 1-4, 6-8, 29-32, and 34-37 under 35 U.S.C. § 102(e) as being anticipated by Kavner, U.S. Patent No. 6,366,947 (hereinafter *Kavner*). Claims 5, 33 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kavner* in view of Mogul, U.S. Patent No. 5,802,292 (hereinafter *Mogul*).

No claim amendments are made herein. Accordingly, claims 1-8 and 27-37 remain pending in the application. For the reasons set forth below, the Applicants respectfully request reconsideration and allowance of all pending claims.

CLAIM REJECTIONS - 35 U.S.C. § 102

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

Claims 1-4, 6-8, 29-32, and 34-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Kavner*. Applicant respectfully asserts that the *Kavner* reference doesn't qualify as prior art under 35 U.S.C. § 102(e). More specifically, in view of the C.F.R. § 1.131 declarations filed herewith, it is clear that subject matter corresponding to the claimed invention of the present application was invented prior to the priority date of *Kavner*, January 20, 1998. As declared by each of the Applicant (Michael Tso) and the Applicant's supervisor at the time of the invention (James Valerio), the subject matter of the claimed invention was reduced to actual practice prior to January 20, 1998. This is further supported by each of Exhibits A and Exhibit B. As stated under the "Value of invention to Intel" section of Exhibit A, "We expect the 1.0 product to be shipped by 4/15/97, with 2 follow on products within six months." As declared by each of Michael Tso and James Valerio, the subject matter of the present invention was

incorporated in the "Scappoose" proxy server, which was a code name for Intel's Quick Web Technology. As identified by the press release of September 25, 1997, market trials of the Intel Quick Web Technology were to begin in October, 1997. Clearly, the subject matter of the present invention was incorporated in an actual product (the Intel Quick Web Technology) prior to the priority date of *Kavner*, and thus reduced to practice prior to the priority date of *Kavner*. Accordingly, *Kavner* does not qualify as a proper 35 U.S.C. § 102(e) reference. Therefore, the rejection of each of claims 1-4, 6-8, 29-32, and 34-37 under 35 U.S.C. § 102(e) as being anticipated by *Kavner* is improper, and should be withdrawn.

With respect to the possible argument that there is no proof of diligence from the date of conception to the actual reduction to practice, this doesn't apply in this situation, since the *actual* reduction to practice is *prior* to the priority date of *Kavner*.

With respect to the inclusion of Jin Jing on the Invention Disclosure Form (IDF) but not being a named inventor in the present application, Jin Jing was the inventor of subject matter that was included in the IDF but not claimed in the present application (*e.g.*, aspects of the client prefetching generation and (remote) proxy request prediction). Rather, this subject matter was included and claimed in another application.

CLAIM REJECTIONS - 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, there must first be some suggestion or motivation to modify a reference or to combine references, and second be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 706.02(j) from *In Re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two

factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed device; and (2) whether the prior art would also have revealed that in so making, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the Applicants' disclosure. *Amgen v. Chugai Pharmaceutical*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), *Fritsch v. Lin*, 21 USPQ2d 1731 (Bd. Pat. App. & Int'f 1991). An invention is non-obvious if the references fail not only to expressly disclose the claimed invention as a whole, but also to suggest to one of ordinary skill in the art modifications needed to meet all the claim limitations. *Litton Industrial Products, Inc. v. Solid State Systems Corp.*, 755 F.2d 158, 164, 225 USPQ 34, 38 (Fed. Cir. 1985).

The examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. M.P.E.P. § 70602(j) from *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Obviousness cannot be established by combining references without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. M.P.E.P. § 2144 from *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) (emphasis added by M.P.E.P.).

Claims 5, 33 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kavner* in view of *Mogul*. In order to support such a 35 U.S.C. § 103(a) rejection, both of *Kavner* and *Mogul* must qualify as proper 35 U.S.C. § 102 references. As argued above, it is clear that *Kavner* does not qualify as a 35 U.S.C. § 102(e) reference (nor qualify as prior art under any other provisions of 35 U.S.C. § 102). Accordingly, the rejection of each of claims 5, 33, and 35 is improper and should be withdrawn.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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